



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/490,529	01/25/2000	Thomas K. Roslak	A31598-A-A-072797.0121	7245

7590 02/01/2005

HIMANSHU S. AMIN  
AMIN & TUROCY, LLP,  
1900 EAST 9TH STREET  
24TH FLOOR, NATIONAL CITY CENTER  
CLEVELAND, OH 44114

EXAMINER

NGUYEN, CUONG H

ART UNIT PAPER NUMBER

3661

DATE MAILED: 02/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/490,529

**Applicant(s)**

ROSLAK ET AL.

**Examiner**

CUONG H. NGUYEN

**Art Unit**

3661

**- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2004.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-12, 14-19, 23-27 and 39-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-12, 14-19, 23-27 and 39-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 February 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

1. This Office Action is the answer to the RCE, and the after-final amendment submitted on 11/19/2004, which papers have been placed of record.

2. Claims 1-8, 10-12, 14-19, 23-27, and 39-47 have been pending for this continuing examination (new claims 39-47 have been added for this RCE).

### **Response**

3. The examiner respectfully submits that pending claims are not eligible for a patentable protection.

The submitted amendment did not narrowing the claimed subject matter to be distinguished from prior art; the examiner told the representative that merely adding a barcode storage device and a proximity sensor to the claimed system do not make claimed subject matter not obvious to one of ordinary skill in the art at the time of invention because a system's configurations comprise structural components or structural modules that making up said claimed system, and the added components are already old and well-known, it is just a matter of integrating known components together - (see *In re Murray*, 19 CCPA 739, 53 F.2d 541, 11 USPQ 155; *In re Zabel et al.*, 38 CCPA 832, 186 F.2d 735, 88 USPQ 367 wherein above barcode storage device and a proximity sensor would be integrated into O'Hagan et al.'s system - There is also a requirement that the integration of those claimed components involve more than mere

mechanical skill, currently the claim does not specify that). The examiner submits that after a supplemental search, pending claims are necessitated new grounds of rejections on obviousness for the amended phrase of including in claimed environment "proximity sensor" for monitoring, and adding "an instruction for generating a theft condition after xxx seconds of receiving a signal".

The new grounds for rejections due to this amendment also applying to claims 2-8, 10-12, 14-19 because they are incorporated rejection's references that are used for claim 1 (Kowala's reference (as a primary reference) is still proper for a "system" claim because it would be obvious to one with ordinary skill in the art at the time of invention to utilize/integrate available electronic components/devices (i.e., a proximity sensor, and a computer instruction to alarm/notice a (theft) condition immediately or after a predetermined period - please note that a timer in the computer is also used as clock) in Kowala's system to perform the claimed functions - please understand that a system claim MUST indicate what component to comprise/make-up that system, not how a component can do; based on that determination).

The presence of process limitations in a product claims, which product does not otherwise patentably distinguish over cited prior art, can not impart

patentability to that product. In re **Stephens** 145 USPQ 656 (CCPA 1965).

The device/apparatus of cited reference clearly can be used such claimed functions and does not impart patentability to the claimed system. Further, claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations (Ex parte **Masham** 2 USPQ2d 1647 (1987)).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being unclear for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention; that is "wherein the associating comprises freely associating...", the term "associating" needs to be defined.

#### Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

5. Re. To claims 1, 39, 41, 46: They are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Hagan et al. (US Pat. 6,314,406), in view of Kolawa et al. (US Pat. 6,236,974), and further in view of Fernandez et al. (US Pat. 6,697,103).

O'Hagan et al. teach a computer system and remote terminals over a communication network (see O'Hagan, Fig.1), comprising:

- a computer structure (see O'Hagan, Fig.1) - i.e., merchant/store servers (a POS), a remote/home terminal, and information servers;

O'Hagan et al. teach about using a barcode storage device for storing codes after reading them, and then transferring them (see O'Hagan, claim 7 and Fig.16 - where UPC codes of products are used for claimed purposes).

O'Hagan et al. teach about using optical sensors to detect proximity (see O'Hagan, claim 8).

O'Hagan et al. do not expressly disclose that "a centrally server/controller for communicating with said terminal/computer system and said remote terminal via a network".

- However, Kolawa et al. disclose that "It is not important how the store server interacts with the store computer system"; Kolawa obviously teach communications can go through an intermediate server then to a store's terminal (see Kowala, 4:10-22).

- O'Hagan and Kolawa did not disclose about generating an alarm signal (i.e., a theft condition) after a period of receiving a camera's signal.

- However, Fernandez et al. suggest that idea using proximity sensor 44 for sensing physical objects (see Fernandez et al., claims 7-8).

- It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the configuration in the system of O'Hagan et al., with Kolawa's teaching and Fernandez et al., because Kolawa clearly

discloses the use of a computer server as a host between a customer in the Internet and a store's terminal; this configuration is much more flexible to many customers and merchant; and Fernandez et al. suggest of using a proximity camera to activating a monitoring condition (by software - see Fernandez 16:18-30) after detecting a "moving" object that implement shopping environment suggested by O'Hagan.

6. Re. To claim 7: It is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Hagan et al. (US Pat. 6,314,406), in view of Kolawa et al. (US Pat. 6,236,974), and further in view of available old and well-known tools for computer's application.

The rationales and references for rejection of claim 1 are incorporated.

It is old and well-know that any computer with a look-up table (LUT) (i.e., a database of products containing related prices of a store), and a calculating function storing in its hard drive & its microprocessor would do conversions as claimed.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the configuration in the system of O'Hagan et al., and Kolawa, with the above facts because that configuration is recognized to be very convenient to modify/edit with current status of prices/products; furthermore, conversion functions



would be made using that store computer's microprocessor and pre-determined formulas.

7. Re. To claim 8: It is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Hagan et al. (US Pat. 6,314,406), in view of Kolawa et al. (US Pat. 6,236,974), and further in view of Fernandez et al. (US Pat. 6,697,103).

The rationales and references for rejection of claim 1 are incorporated.

The examiner respectfully submits that it is old and well-known that a computer using a modem for communication with secured lines because artisans in the art would recognize that it needs a secured and critical line in transactions relating to money; and silent communications were known to be available options (a designer's choice - "...transferring data to and from the shopping terminal without disturbing a user" is merely an intent of use) that a user would select to turn ON/OFF depending on that user's desire (e.g., turning ON/OFF that computer's speakers).

8. Re. To claim 14: It is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Hagan et al. (US Pat. 6,314,406), in view of Kolawa et al. (US Pat. 6,236,974), and further in view of Fernandez et al. (US Pat. 6,697,103).

The rationales and references for rejection of claim 1 are incorporated.

The examiner submits that Kowala teaches about integrating communications means for interfacing ports that utilize local/remote communications, e.g. components in a master computer/controller on a network that can control slave computers for communicating voice data, ordering goods remotely via Internet.

O'Hagan et al. do not expressly disclose those claimed means.

- However, Kolawa et al. obviously disclose the utilization of those means by showing a communication structure in Fig.1, references 40, 50, 60, and 70.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the configuration in the system of O'Hagan et al., and Kolawa because Kolawa clearly discloses the use of a computer structure to communicate with the Internet; this configuration shows communication's capabilities when using a computer coupling to the Internet.

9. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Hagan et al. (US Pat. 6,314,406), in view of Kolawa et al. (US Pat. 6,236,974), in view of Fernandez et al. (US Pat. 6,697,103), and further in view of Wren (US Pat. 6,055,514).

The rationales and references for rejection of claim 1 are incorporated.

O'Hagan et al., Fernandez et al., and Kolawa et al. do not disclose a shopping terminal using means for fingerprint identification.

The examiner submits that using finger-print for verification has been well-known in business transaction (see **Wren**, 12:14-34): "For an application of this system in homes the input device could be a television remote control device perhaps with alterations comprising cursor movement keys, a joystick, or a microphone for voice input. In recording this product information the customer can then save or take the desired information with him for his later review which might comprise instructions for use, operation, or assembly and can include a list of suggested products or services as advised by the live representative or by the central facility computer. Such information might be recorded on paper, magnetically such as upon a cassette, video tape, computer disc, CD, or a chip embedded or smart card, or by some other means. Comparably the central facility can record the transaction for later retrieval so the customer can continue where he left off at a later date should his interest renew or for identification purposes or for possible assistance in resolving disputes. Other means to verify identification of the customer can be used comprising magnetically encoded badges or cards, or the use of eye or finger scanning devices. Additionally, a mail bag

28 or other means for remitting payment or documents is provided at the remote facility 14.").

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the above configurations in the systems of O'Hagan et al., Kolawa et al., Fernandez et al., and Wren because artisans would recognize that means for biometric verifying a customer identification using finger-prints are very distinguishable in a money transaction.

10. As to claims 2, 40, 43: They are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Hagan et al. (US Pat. 6,314,406), in view of Kolawa et al. (US Pat. 6,236,974), in view of Fernandez et al. (US Pat. 6,697,103), and further in view of Ruppert et al. (US Pat. 5,424,524).

The rationales and references for rejection of claim 1 are incorporated.

O'Hagan et al., Fernandez et al., and Kowala et al. do not disclose a portable shopping terminal comprising an elongated pen-shaped housing having an end with an optically transparent passage there through.

However, since this is an application for a utility patent, not for a design patent; the examiner submits that claimed device's functionality is equivalent to a scanner

with a pen-shaped housing that Ruppert et al. have in their system (see **Ruppert et al.**, Figs. 1, and 3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the configurations in the systems of O'Hagan et al., Fernandez et al., Kolawa et al., and Ruppert et al. because artisans would recognize that improving comfortable by changing structural configuration of a pen while scanning bar-codes.

11. As to claim 3: It is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Hagan et al. (US Pat. 6,314,406), in view of Kolawa et al. (US Pat.6,236,974), in view of Fernandez et al. (US Pat. 6,697,103), and further in view of Ruppert et al. (US Pat. 5,424,524) and Bianco (US Pat. 5,047,614).

The rationales and references for rejection of claim 1 are incorporated.

Ruppert et al. further teach a computer system and remote terminals over a communication network, wherein said shopping terminal is a portable terminal, said portable terminal comprising:

- a structure with a touch sensitive display disposed on said front surface; buttons to activate scanning functions; a bar-code reader, said bar code reader having (see **Ruppert et al.**, the abstract, and Fig.1);

Since this is an application for a utility patent, not for a design patent. The examiner submits that Bianco teaches a portable scanner with a housing, activation button/switch, means for reading bar codes, and this scanner performs equivalent functions as claimed (see **Bianco**, Fig.4).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the configurations in the systems of O'Hagan et al., Kolawa et al., Fernandez et al., Bianco, and Ruppert et al. because artisans would recognize that structural configuration makes a scanner easy to hold as a pen in scanning barcodes.

12. As to claim 4: It is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Hagan et al. (US Pat. 6,314,406), in view of Kolawa et al. (US Pat.6,236,974), in view of Fernandez et al. (US Pat. 6,697,103), and further in view of Ruppert et al. (US Pat. 5,424,524) and Bianco (US Pat. 5,047,614).

The rationales and references for rejection of claim 3 are incorporated.

O'Hagan et al., Fernandez et al., and Kowala do not disclose that "portable terminal further comprises a touch sensitive area within said touch sensitive display for receiving data inputs from a pen" and a scanner with "an elongated pen-shaped".

However, Ruppert et al., and Bianco teach those limitations.

Ruppert et al. teach a computer system and remote terminals over a communication network wherein said portable terminal further comprises a touch sensitive area within said touch sensitive display for receiving data inputs from a pen (see Ruppert et al., the abstract, and Fig.1).

Since this is an application for an utility patent, not for a design patent. The examiner submits that "an elongated pen-shaped ... .." is equivalent to a scanner that Bianco teaches (see Bianco, Fig.4).

The examiner submits that it is obvious to one with ordinary skill in the art to use any available type of input (e.g., keyboard, pen, voice recognitions .etc.). an elongated pen-shaped housing having an end with an optically transparent passage there through.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the configurations in the systems of O'Hagan et al., Kolawa et al., Fernandez et al., Bianco, and Ruppert et al. because artisans would recognize that combination creates a configuration being easy to hold as a pen in scanning barcodes for scanning shopping products.

13. As to claim 5: It is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Hagan et al. (US Pat. 6,314,406),

in view of Kolawa et al. (US Pat. 6,236,974), in view of Fernandez et al. (US Pat. 6,697,103), in view of Ruppert et al. (US Pat. 5,424,524) and in view of Bianco (US Pat. 5,047,614).

The rationales and references for rejection of claim 3 are incorporated.

**Bianco** also teaches a computer system and a scanner terminal/ (a remote terminal) over a communication network.

Bianco doesn't disclose a portable scanner comprising an information key for allowing a user to display product information.

However, the examiner respectfully submits that a portable terminal such as in cited references comprises an information key for allowing a user to display product information has been well-known in computer users (e.g., a "hot" key).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the configurations in the systems of O'Hagan et al., Kolawa et al., Fernandez et al., Bianco, Ruppert et al., because artisans would recognize that configuration is easy to remember a special key that doing a familiar function on a portable device in shopping environments.

14. As to claim 6: It is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Hagan et al. (US Pat. 6,314,406),



in view of Kolawa et al. (US Pat. 6,236,974), in view of Fernandez et al. (US Pat. 6,697,103), and further in view of Bianco (US Pat. 5,047,614).

The rationales and references for rejection of claim 1 are incorporated.

**Bianco** et al. further teach a computer system and remote terminals over a communication network wherein said computer's microprocessor creates a customer's profile.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the configurations in the systems of O'Hagan et al., Kolawa et al., Fernandez et al., Ruppert et al., and Bianco because artisans would recognize a familiar teaching of a computer system and remote terminals over a communication network wherein said controller comprises inference means for deriving a shopping profile for the customer.

15. As to claim 10: The rationales and references for rejection of claim 1 are incorporated.

**O'Hagan** et al. teach a computer system and remote terminals over a communication network (see **O'Hagan**, the abstract, Fig. 1); wherein said bar code storage device comprises:

- communication means for transferring said bar codes to said controller over said at least one network

- a bar code reader for reading bar codes from a hardcopy source, said bar code reader having a visible light indicator for indicating the scanning status of the barcode reader;
- memory storage mean coupled to said bar code reader for storing said bar-codes.

O'Hagan et al. do not disclose: one bar code activation button located on the top surface of said barcode storage device for activating said bar code reader; a housing (not necessary an egg-shaped housing because this is a utility application for patent, not a designed patent).

However, Ruppert et al. teach those features (see **Ruppert et al.**, the abstract, and Fig.1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the configurations in the systems of O'Hagan et al., Kolawa et al., Fernandez et al., and Ruppert et al. because artisans would recognize that configuration is easy to hold as a pen in scanning barcodes while doing a shopping.

16. As to claims 11, 43: The rationales and references for rejection of claim 1 are incorporated.

**Ruppert et al.** teach a computer system and remote terminals over a communication network, wherein said at least one shopping terminal comprises a scanning system comprising a wearable computer processor and a wearable scanning device in communication with the computer processor

(Please note that Ruppert et al.'s portable device is lightweighted that can be wearable).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the configurations in the systems of O'Hagan et al., Kolawa et al., Fernandez et al., and Ruppert et al. because artisans would recognize that configuration is easy to hold as a pen in scanning barcodes while doing shopping.

17. As to claims 12, 44: The rationales and references for rejection of claim 11 are incorporated.

**Ruppert** et al. teach a computer system and remote terminals over a communication network wherein said scanning system further comprises a headset having a speaker and a miniature display device for providing a audio, graphical and video information (see Ruppert, the abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the configurations in the systems of O'Hagan et al., Kolawa et al., Fernandez et al., and Ruppert et al. because artisans would recognize that configuration is easy to hold as a pen in scanning barcodes while doing shopping.

18. As to claims 15, 45: The rationales and references for rejection of claim 14 are incorporated.

**Ruppert** et al. teach a computer system and remote terminals over a communication network said controlling

means (see **Ruppert**, the abstract "A microprocessor coupled to a bar code reader,") comprises:

- means for starting and restarting the operation of said shopping system;

means for terminating the operation of said shopping system;

- means for displaying the operational status of said shopping system; means for controlling the day-to-day operations and maintenance tasks of the shopping system;

- means for displaying the status of communications related to said shopping system (see **Ruppert**, the abstract, Fig. 1);

- means for preparing said shopping system to accept an upcoming day's transactions (see **Ruppert**, the abstract "A microprocessor coupled to a bar code reader,");

- means for transferring price data files from the POS system to said controller (see **Ruppert**, the abstract, Fig. 1); and

- means for allowing a system operator to disable checking on transactions by said controller so as to speed up checkout processing during busy periods .

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the configurations in the systems of O'Hagan et al., Kolawa et al., Fernandez et al., and Ruppert et al. because artisans

would recognize that configuration is easy to hold as a pen in scanning barcodes.

19. As to claim 16: The rationales and references for rejection of claim 14 are incorporated.

**Ruppert** et al. teach a computer system and remote terminals over a communication network wherein said controlling means comprises means for processing transactions related to said shopping establishment including start of day processing, normal store processing, end of day processing and overnight processing (see **Ruppert**, the abstract, Fig. 3);.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the configurations in the systems of O'Hagan et al., Kolawa et al., Fernandez et al., and Ruppert et al. because artisans would recognize that configuration is easy to hold as a pen in scanning barcodes for scanning shopping products.

20. As to claim 17: It is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Hagan et al. (US Pat. 6,314,406), in view of Kolawa et al. (US Pat. 6,236,974), in view of Fernandez et al. (US Pat. 6,697,103), and further in view of Ruppert et al. (US Pat. 5,424,524).

The rationales and references for rejection of claim 14 are incorporated.

**Ruppert** et al. teach a computer system and remote terminals over a communication network, wherein said means for remotely ordering goods is used to generate a picking list from a home computing terminal having access to the Internet (see **Ruppert**, the abstract, Fig. 3);.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the configurations in the systems of O'Hagan et al., Kolawa et al., Fernandez et al., and Ruppert et al. because artisans would recognize that configuration is easy to hold as a pen in scanning barcodes.

21. As to claim 18: It is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Hagan et al. (US Pat. 6,314,406), in view of Kolawa et al. (US Pat. 6,236,974), in view of Fernandez et al. (US Pat. 6,697,103), and further in view of Ruppert et al. (US Pat. 5,424,524).

The rationales and references for rejection of claim 1 are incorporated.

For assisting a customer in shopping, Ruppert et al. teach a computer system and remote terminals over a communication network, wherein said shopping terminal is a portable terminal comprising means for freely associating with a corresponding communications network (e.g., "a portable terminal" here can be a telephone network using

modem, a cable modem for Internet line, a wireless modem .etc.), (see **Ruppert**, the abstract, and Fig. 3 - ref. 85).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the above configurations in the systems of O'Hagan et al., Kolawa et al., Fernandez et al., and Ruppert et al. because they give more conveniences to users/customers.

22. Claims 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolawa et al. (US Pat.6,236,974), in view of Fernandez et al. (US Pat. 6,697,103), and in view of the Official Notice.

A. Re. To claim 23: In addition to Kolawa et al.

suggestions, the examiner submits that it is old and well-known that **United Parcel Service (UPS)** practices following steps:

- associating a terminal with a server and a user/customer (by using a scanner to input related data - e.g., delivering time at a customer's address, the scanner is a means to do an association);
- scanning an item using a scanner at a delivery address;
- returning the scanner to the terminal receptacle (e.g., for battery charging, or for waiting of another usage);

- generating a receipt corresponding to a scanned item (e.g., a portable scanner couples to a computer and a printer); and
- distributing/purchasing a scanned item at a check-out station (e.g., at IKEA furniture stores, customers performed such step - therefore, the issue is just automation old manual steps in this claim - see in re Venner).

B. Re. To claim 24: In addition to Kolawa et al.'s suggestions, the Official Notice is taken that it is old and well-known with following claimed steps:

- checking-in by a customer (sign-in for services after arrival at a spot - e.g., in Lens Crafter stores, or sign-up for a service at a public library);
- authorizing a terminal/computer for use (at a public library); and
- obtaining an authorized terminal from its location (e.g., a librarian assigns an authorized computer to a patron).

C. Re. To claim 25: In addition to Kolawa et al. suggestions, the examiner respectfully submits that a step of associating a terminal with a network is old and well-known (e.g., a library patron registers to surf the web).

D. Re. To claim 26: In addition to Kolawa et al. suggestions, the examiner respectfully submits that it is



old and well-known for a customer to practice following steps:

- generating a list from a remote location (e.g., customer orders from bestbuy.com using a generated shopping list - this step also can be done manually);
- forwarding said list to a controller/server (e.g., customer orders from bestbuy.com input a shopping list via a computer's keyboard);
- generating a picking list at the server/controller corresponding to items identified in the shopping list (e.g., generating a print-out for picking up items at a bestbuy warehouse); and
- collecting the items identified in the picking list for check-out/delivery (e.g., put items in said picking list in one box to scan barcodes on them for obtaining prices of ordered items).

E. Re. To claim 27: In addition to Kolawa et al.

suggestions, the examiner respectfully submits that it is old and well-known with a customer to do following steps:

- generating a (shopping) list (e.g., customer orders from bestbuy.com using a shopping list);
- forwarding said list to a server/controller (e.g., bestbuy.com practice);

- generating a picking list at the server/controller (corresponding to items identified in a shopping list) this step is a MUST in order to do business;
- assigning a barcode to the picking list (e.g., this step has been done for UPS package; moreover, it can be a designer's choice to easily recognize different orders);
- printing a label showing the picking list ID barcode (e.g., this step has been done for UPS packages);
- scanning items corresponding to said picking list (e.g., checking out at circuit city stores); &
- collecting scanned items for check-out (this step is a MUST in order to do business; e.g., amazon.com business practice).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the above old and well-known steps with Fernandez et al. and Kowala et al.'s teachings, because artisans would recognize these steps are logic procedures, organized and in good orders for being successful in various business practices.

24. Re. to claim 43: This claim contains limitations of both claim 2 and claim 11; therefore, it is rejected on 35 USC 103(a) for obviousness based on set forth rationales and references.

25. Re. To claims 42, 47: They are rejected under 35

U.S.C. 103(a) as being unpatentable over O'Hagan et al. (US Pat. 6,314,406), in view of Kolawa et al. (US Pat. 6,236,974), in view of Fernandez et al. (US Pat. 6,697,103), and further in view of Stevens (US Pat. 5,496,540).

The rationales and references for rejection of claim 1 are incorporated.

Stevens also has a controller to activate a camera upon receive a signal since a camera connected to a controller (see Stevens, the summary).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the above configurations in the systems of O'Hagan et al., Kolawa et al., Fernandez et al., and Stevens et al. because they automatically activate a device when an event happens; that gives more conveniences to users/customers.

#### **Conclusion**

26. Claims 1-8, 10-12, 14-19, 23-27, and 39-47 are not patentable.

27. These following references are also considered combinable to meet claimed limitations:

The examiner submits that Wren (US Pat. 6,055,514 - filed 6/21/1996 and published on 4/25/2000) suggests claim 19 's limitation.

The following US Pat. suggest: scanning items to be purchased, collecting a scanned list, purchasing items at check-out point .

- **Stevens**, (US Pat. 6,327,570 - 12/2001, filed 11/06/1998, class 705/7,10), Personal business service system and method, about system and method of computerizing companies with customized individual addressable electronic direct marketing, self-service automation, and customer care support. The system contains a private network connecting product companies, manufacturers, stores, educational institutions, travel companies, medical providers, financial institutions, and many others to a specified individual customer. The connection is made to a personal agent device carried or worn by a participating consumer that contains local processing means with an interactive display, security features, optional camera, and wireless communications with the private network. Communications microchips can be placed on products that communicate product information upon interrogation with the personal agent. The invention also includes business professional units in communication with the private network and in-store local wireless communication between personal agents and the business professional unit; docking stations for personal agent devices are also suggested.

- Oosterveen et al., (US Pat. 5,468,942 - 11/21/1995),

Dispensing device for hand scanners accessible from two sides, wherein said device is used in a self-service store adapted for use of a self-scanning system, said device comprises an identification device for customers and accommodating elements for hand scanners.

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose telephone number is 703-305-4553. The examiner can normally be reached on 7am - 3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas G. Black can be reached on 703-305-8233. The fax phone number for the organization where this application is assigned is 703-305-7687.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S.N. 09/490,529  
Art Unit 3661

*Cuonghnguyen*

*CHN*  
CUONG H. NGUYEN  
Primary Examiner  
Art Unit 3661